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**D E C I S I O N**  
**of 18 June 2004**

**Case Number:** J 0017/03 - 3.1.1

**Application Number:** 97122882.0

**Publication Number:** 0857439

**IPC:** A47B 1/05

**Language of the proceedings:** EN

**Title of invention:**  
Draw-leaf table

**Applicant:**  
Lucatello, Luciano

**Opponent:**  
-

**Headword:**  
Re-establishment/LUCATELLO

**Relevant legal provisions:**  
EPC Art. 86(1),(2),(3), 113(1), 116(2), 122(1),(2),(3)  
EPC R. 37(1), 69(1)

**Keyword:**  
"Refusal of oral proceedings before Receiving Section -  
procedural violation (no)"  
"Request for re-establishment - all due care (no)"

**Decisions cited:**  
J xx/xx (OJ, EPO 1985, 159), J 0003/93, T 0287/84, T 0381/93

**Catchword:**  
-



Case Number: J 0017/03 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 18 June 2004

**Appellant:** Lucatello, Luciano  
Via d'Annunzio, 114  
I-31030 Biancade (Treviso) (IT)

**Representative:** Agostini, Agostino  
Dragotti & Associati srl  
Via Paris Bordone, 9  
I-31100 Treviso (IT)

**Decision under appeal:** Decision of the Receiving Section of  
16 December 2002 rejecting the request for re-  
establishment into the time limit for payment  
of the renewal fee for the third year and the  
request for oral proceedings.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** R. Moufang  
S. C. Perryman

## Summary of Facts and Submissions

- I. The present appeal concerns the decision of the Receiving Section of 16 December 2002 which rejected the request of the appellant for re-establishment into the time limit for payment of the third renewal fee for the European patent application 97 122 882.0.
- II. The patent application was filed on 24 December 1997. By a communication sent to the former representative of the appellant on 2 August 2000, the Receiving Section of the EPO noted a loss of rights (Rule 69(1) EPC). According to the communication the patent application was deemed to be withdrawn under Article 86(3) EPC since the renewal fee for the third year and the additional fee had not been paid in due time.
- III. With letter filed on 18 December 2000, the appellant applied for re-establishment into the time limit for payment of the third year renewal fee. He stated grounds for his request and set out facts on which he relied. At the same date he paid the renewal fee for the third year together with an additional fee and the fee for re-establishment of rights. He also requested oral proceedings.
- IV. After an exchange of communications and letters between the Receiving Section and the appellant and after a consultation by telephone, the request for re-establishment was rejected. In its decision the Receiving Section considered the request to be admissible, but not allowable.

V. The submissions of the appellant in the first instance proceedings and in the appeal proceedings can be summarised as follows:

- (a) The Receiving Section should have appointed oral proceedings since the issue of re-establishment could have been clarified thereby in a quicker and safer way.
- (b) As an individual applicant, the appellant was not familiar with the requirements of the EPC and had not realised the importance of the matter. He only had some experience with the patent granting procedure before the Italian industrial property office where the third year renewal fee is paid with the filing fee.
- (c) The only information he received from his former representative with respect to the payment of the third year renewal fee for the present application was a letter headed "Patents: Tax Reminder" and dated 13 April 2000. However, this letter contained ambiguous information concerning the date up to which the fee could still be paid without losing the application. He was therefore misled into believing that he had more time for paying the fee than he actually had.
- (d) In May 2000 the appellant revoked the appointment of his former representative since he intended to entrust the handling of the application to his actual representative. For a number of reasons (extensive business travelling of the appellant, change of affiliation and temporary unavailability

of the new representative), the actual representative was unfortunately appointed only on 13 November 2000. Since the appellant was not aware of the deadline of 30 June 2000 for paying the third year renewal fee together with the additional fee, the deadline was missed without personal fault.

- (e) The appellant did not receive the loss of right communication of 2 August 2000 since it was sent out by the EPO to his former representative. The cause of non-compliance for the purposes of Article 122(2) EPC was only removed on 1 December 2000 when his newly appointed representative found out by inspection of the register that a loss of right communication had been sent out.

VI. On 18 June 2003 oral proceedings took place. The appellant requested that the decision under appeal be set aside and that the application be restored into full force. At the end of the oral proceedings the chairman announced the Board's decision.

### **Reasons for the Decision**

1. The appeal satisfies the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. In his grounds of appeal, the appellant raised a procedural complaint against the rejection of his request for oral proceedings by the Receiving Section. According to Article 116(2) EPC, oral proceedings before the Receiving Section shall take place only

where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application. Since a decision confirming a loss of right or refusing a requested re-establishment of rights is not to be equated with the refusal of an application (see J xx/xx, OJ EPO 1985, 159, point 4), the Receiving Section had a discretion in dealing with the appellant's request for oral proceedings. While the discretion foreseen in Article 116(2) is not without limits and has to be exercised in the light of recognised procedural principles such as the right to be heard set out in Article 113(1) EPC, the Board notes that in the present case the Receiving Section has given the appellant ample opportunity to present its case. Several letters and communications were exchanged and a consultation by telephone took place. Under these circumstances, the Board comes to the conclusion that the refusal of oral proceedings before the Receiving Section does not amount to a procedural violation.

3. The present application being filed on 24 December 1997, the renewal fee for the third year became due on 31 December 1999 (Article 86(1), Rule 37(1) EPC) and the six-months period for payment of this fee together with an additional fee expired on 30 June 2000 (Article 86(2) EPC). However, the fee was not paid by that date. Thus, pursuant to Article 86(3) EPC, the application is deemed to be withdrawn unless the rights of the appellant are re-established by virtue of Article 122(1) EPC.
4. Requests for re-establishment must be filed within two months from the removal of the cause of non-compliance with the respective time limit (Article 122(2) EPC). In

the present case, the cause of non-compliance was the appellant's unawareness of the expiration of the time limit for payment of the third year renewal fee together with an additional fee. The Board sees no reason to question the appellant's submissions that he did not receive the loss of right communication of 2 August 2000 which was sent out by the EPO to his former representative after revocation of the appointment, and that he gained knowledge of the missed deadline only when his new representative inspected the file on 1 December 2000. It can therefore be assumed that the request for re-establishment filed on 18 December 2000 was submitted in time. Since the request also complies with the further requirements laid down in Article 122(2) and (3) EPC, it is admissible.

5. The request for re-establishment would be allowable if the appellant was unable to observe the time limit in question despite having taken all due care required by the circumstances (Article 122(1) EPC). In this context, the word "all" is important (T 287/84, OJ EPO 1985, 333, point 2) so that the requirement of all due care has to be regarded as a strict one. The circumstances of the individual case have to be considered in their entirety in order to objectively evaluate whether the observance of the time limit was impossible for the applicant. The duty of all due care applies both to the applicant himself and to his professional representative (J 3/93 of 22 February 1994, point 2.1; T 381/93 of 12 August 1994, point 6).
  
6. The appellant is an individual applicant who had entrusted the filing of the present application to a

professional representative. In April 2000 the office of the representative sent him a letter headed "Patents: Tax Reminder". The letter contained information in Italian and English. It indicated the 13 April 2000 as reminder date ("data avviso"). The 10 May 2000 was prominently mentioned as the last date for instructions by the words "TERMINE ULTIMO VS. ISTRUZIONI : 10.05.2000". Furthermore, a left-column box to be read by Italian applicants contained the following text:

"Per i brevetti sottoriportati, è necessario che - entro il 10 del mese successivo a quello della 'data avviso' - ci restituiate l'unita copia, inviandoci l'importo per i brevetti da mantenere in vita e cancellando quelli non più di Vs. interesse. Il ritardo nel pagamento fa incorrere in multe governative; dopo sei mesi il ritardo determina la decadenza definitiva del brevetto."

In a further box, the present application was listed. The 24 December 1999 was indicated as the due date for the third annuity.

7. The "tax reminder" thus informed the appellant about the fact that a third year renewal fee had to be paid for the present application and that this fee had already fallen due several months ago. It further informed the appellant about the necessity to instruct the representative prior to 10 May 2000. It is true that the tax reminder contained rather ambiguous information concerning the legal consequences of non-payment. The above cited Italian text could be interpreted to mean that a failure to pay within the time limit of 10 May 2000 would only lead to



- "administrative fines" ("multe governative"), i.e. additional fees, and that a loss of right would only occur 6 months thereafter. Nevertheless, the appellant was clearly warned by the tax reminder that a legally important time period was running and that he should instruct his representative not later than 10 May 2000 for payment of the third year renewal fee.
8. In this situation, the appellant chose to revoke the appointment of the representative. This was apparently done in order to entrust the matter to his current representative. While the appellant was certainly free to change his representative and to handle the matter in the meantime himself, he should have been aware that, as long as the new representative was not yet appointed, he had to take care himself of any time limit connected with the payment of the third year renewal fee. In view of the content of the tax reminder, he could not simply rely on the assumption that the payment of renewal fees under European law followed the same rules as applicable under the Italian patent grant procedure.
9. The standard of all due care enshrined in Article 122(1) EPC requires that, in case of doubt or legal uncertainty, the applicant takes all those steps which can be reasonably expected from a diligent person. Having apparently encountered difficulties in contacting the current representative, the appellant should at least have sought advice with respect to the payment of the third year renewal fee either from his former representative, or from another representative or the European Patent Office before expiry of the internal deadline of 10 May 2000 indicated in the tax reminder. However, the appellant did not undertake any

steps at all before appointing the current representative only in November 2000. In view of these circumstances, the Board has come to the conclusion that the requirement of all due care was not met by the appellant. Thus the request for re-establishment into the time limit for payment of the third year renewal fee is not allowable and the appeal has to be dismissed. This entails that fees paid after 30 June 2000 other than the fee for re-establishment of rights and other than the appeal fee are to be refunded.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset